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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,398	08/14/2001	Donald S. Krysinski	019333-000210US	9152
20350 7590 07/25/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER LOFTIS, JOHNNA RONEE	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/929,398

Applicant(s)

KRYNSKI ET AL.

Examiner

Johnna R. Loftis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-24, 26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-24, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. In view of the Appeal Brief filed on 2/20/07, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Response to Arguments

2. Applicant's arguments, with respect to the rejection(s) of claim(s) 1, 2, 7-9, 12 and 13 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tarr et al, US 5,184,179. Applicant argues Tarr fails to teach "reporting information related to the service contract electronically and automatically to the user" as recited in claim 1. Examiner has asserted that since Tarr teaches a user receiving diagnostic signals (column 3, lines 24-29) and a billing operator receiving the contract information (column 6, lines 18-23) that it

would have been obvious to transmit the contract information to the user in addition to the billing operator. This transmission of information to the user does not change the functionality of the system. Rejections have been modified below.

With respect to Applicants second group of arguments directed to the wireless notification, Applicant has attempted to challenge the Examiner's taking of Official Notice. There are minimum requirements for a challenge to Official Notice:

(a) In general, a challenge, to be proper, must contain adequate information or arguments so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice

(b) Applicants must seasonably traverse (challenge) the taking of Official Notice as soon as practicable, meaning the next response following an Office Action. If an applicant fails to seasonably traverse the Official Notice during examination, his right to challenge the Official Notice is waived.

Applicant has not provided adequate information or arguments so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The Examiner's taking of Official Notice has been maintained.

Bald statements such as, "the Examiner has not provided proof that this element is well known" or "applicant disagrees with the Examiner's taking of Official Notice and hereby requests evidence in support thereof", are not adequate and do not shift the burden to the Examiner to provide evidence in support of the Official Notice.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14, 17-24, 26 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Tarr et al, US 5,184,179.

Claims 3-6, 10, 11, 14, 17-24, 26 and 28 are

As per **claim 1**, Tarr et al teaches providing data capture device proximate to a business machine, the business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof (column 3, lines 24-29 – photocopier monitoring system that monitors the diagnostic signals, and upon detection of a diagnostic signal, translates the signal into a signal usable by an off site end user to determine the condition of the photocopier); automatically determining a threshold event associated with the service contract, the threshold event comprising a selection from the group consisting of a usage count for the business machine, a detected error in the business machine, a predetermined time period, and any combination thereof (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval); programming the threshold event into the data capture device, wherein the data capture device monitors the business machine to log an occurrence of the threshold event (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval; column 5, lines 14-30); and receiving notification from the data

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capture device that the threshold event was logged by the data capture device, wherein the logging of the threshold event triggers the notification (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); but does not explicitly teach reporting information related to the service contract electronically and automatically to the user based, at least in part, upon the receiving step.

Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to report contract information to the user since Tarr et al teaches reporting the contract information to a billing operator. Nothing precludes the billing operator from being a “user” and by sending this information to a user, it does not change the functionality of the system. Transmitting the contract information to the user keeps them up to date as to the status of the operational agreement.

As per **claim 2**, Tarr et al teaches a step of receiving a service call by a technician automatically generated from user input (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person).

As per **claim 3**, Tarr et al teaches a step of notifying a technician of a service call for the business machine (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 4**, Tarr et al teaches contacting the user by the technician based upon the notifying step (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person to travel to the site of the problem), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 5**, Tarr et al teaches receiving service contract information from user (column 6, lines 20-23 – the billing operator is notified when service contract termination occurs), and teaches the computer control causes a modem to transmit signals to a billing computer (column 3, lines 56-58), but does not explicitly teach the receiving of information is by way of a web interface for an operations center. It was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of ordinary skill in the art to modify Tarr et al to include a web interface for communication. This would have made the communication process quicker and more efficient.

As per **claim 6**, Tarr et al teaches monitoring contract termination intervals and automatically providing the appropriate service requirement in response (column 3, lines 40-47), but does not explicitly teach determining if automatic contract renewals are authorized, and automatically renewing the service contract if authorized. Since Tarr et al monitors usage levels and contract termination intervals, it would have been obvious to one of ordinary skill in the art

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to modify Tarr et al to include automatic renewal of the contract. By including automatic renewal of contracts, the service or billing personnel could ensure service would be provided to those who may have let their contract expire. In other words, the automatic contract renewal incorporated into Tarr et al would ensure appropriate service is provided to customers.

As per **claim 7**, Tarr et al teaches programming the threshold event into the data capture device from a point remote to the data capture device (column 5, lines 8-23 – the clock is set for sending a signal at a predetermined time interval).

As per **claim 8**, Tarr et al teaches the determining step is performed at a point remote to the data capture device (column 5, lines 40-44 – transfers the count information by modem to the billing computer).

As per **claim 9**, Tarr et al teaches the data capture device includes a mechanism for placing a service request when manually activated (column 8, lines 20-24 – the central station dispatches a service person).

As per **claim 10**, Tarr et al teaches the information is sent using a modem (column 5, lines 20-23), but does not explicitly teach the data capture device comprises a wireless transceiver. However, it would have been obvious at the time of the invention to include wireless transmission of the count data as a way to more efficiently receive and process information for billing purposes.

As per **claim 11**, Tarr et al teaches monitoring contract termination intervals and automatically providing the appropriate service requirement in response (column 3, lines 40-47), but does not explicitly teach the threshold event is one of the following: a first percentage of a contract period; and a second percentage of a contract period. However, it would have been

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obvious to one of ordinary skill in the art to modify Tarr et al to monitor the contract period. By modifying Tarr et al to include monitoring the contract period, setting alerts at points along the contract length, the service personnel would be aware of the status of the customer and could make appropriate offerings to the customer. For instance, if the service personnel is notified that a contract is 90% complete, the service personnel could offer a renewal as an early warning, and then when the contract is up (100% complete), the service personnel could again offer the renewal to ensure there are no lapses in the contract agreement.

As per **claim 12**, Tarr et al teaches querying the data capture device for information (column 5, lines 43-59 – as count information comes into the billing computer, a comparison is made between incoming identification information with stored identification information).

As per **claim 13**, Tarr et al teaches remotely monitoring usage of supplies; and notifying the user when ordering of supplies is predicted to be warranted (column 5, lines 60-68 – by knowing the number of copies made, a monthly total of consumed goods may be calculated – this allows the central station to maintain a consumable goods inventory – the central station then arranges for replenishment).

Tarr et al teaches the system of **claim 14** as applied to claim 1 above, but does not explicitly teach the receiving of information is by way of a web interface for an operations center. It was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of ordinary skill in the art to modify Tarr et al to include a web interface for communication. This would have made the communication process quicker and more efficient.

As per **claim 17**, Tarr et al teaches a plurality of service technicians are assigned to the plurality of business machines (column 8, lines 20-55 – each service technician is dispatched to the business machine site).

As per **claim 18**, Tarr et al teaches each of the plurality of data capture device is integral to its associated business machine (column 3, lines 12-49 – the copier has a counter that displays a count value corresponding to the number of sheets of paper processed by the machine).

As per **claim 19**, Tarr et al teaches a plurality of service terminals that receive service calls for the plurality of business machines (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person to travel to the site of the problem), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 20**, teaches at least one of the plurality of data capture devices comprises a mechanism for requesting a service call (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person to travel to the site of the problem), but does not explicitly teach the request being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians

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more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 21**, Tarr et al teaches at least one transceiver is coupled to a data center transceiver wherein the data is transferred to the operations center using a modem (column 3, lines 50-58), but does not explicitly teach the wireless data center transceiver is coupled to a wide area network, and the wide area network is coupled to the operations center. However, it would have been obvious to one of ordinary skill in the art the time of the invention to incorporate wireless communication of a wide area network. It would have been obvious to modify Tarr et al with wireless communication over a wide area network as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 22**, Tarr et al teaches providing data capture device proximate to a business machine, the business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof (column 3, lines 24-29 – photocopier monitoring system that monitors the diagnostic signals, and upon detection of a diagnostic signal, translates the signal into a signal usable by an off site end user to determine the condition of the photocopier); automatically determining a threshold event associated with the service contract, the threshold event comprising a selection from the group consisting of a usage count for the business machine, a detected error in the business machine, a predetermined time period, and any combination thereof (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval);

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programming the threshold event into the data capture device, wherein the data capture device monitors the business machine to log an occurrence of the threshold event (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval; column 5, lines 14-30); receiving notification from the data capture device that the threshold event was logged by the data capture device, wherein the logging of the threshold event triggers the notification (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); notifying a technician to service the business machine, wherein the notifying occurs automatically in response to the notification from the capture device (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 23**, Tarr et al teaches reporting information related to the service contract electronically and automatically to the user based, at least in part, upon the receiving step (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval).

As per **claim 24**, Tarr et al teaches the threshold event is a malfunction in the business machine (column 7, lines 4-16 – diagnostic signal is sent if there is system failure).

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As per **claim 26**, Tarr et al teaches receiving service contract information from user (column 6, lines 20-23 – the billing operator is notified when service contract termination occurs), and teaches the computer control causes a modem to transmit signals to a billing computer (column 3, lines 56-58), but does not explicitly teach the receiving of information is by way of a web interface for an operations center. It was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of ordinary skill in the art to modify Tarr et al to include a web interface for communication. This would have made the communication process quicker and more efficient.

As per **claim 28**, teaches each capture device is coupled to an associated business machine, each associated business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof column 3, lines 24-29 – photocopier monitoring system that monitors the diagnostic signals, and upon detection of a diagnostic signal, translates the signal into a signal usable by an off site end user to determine the condition of the photocopier), each data capture device is configured to monitor is associated business machine and to log monitored events (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval; column 5, lines 14-30); and operations center in two-way communication with each of the plurality of data capture devices, wherein the operations center is configured to: determine a threshold which triggers a service to be performed by a technician pursuant to a service contract, the threshold comprising a selection from the group consisting of a usage count for the business machine, a predetermined time period, and any combination thereof (column 3, lines 35-45 –

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count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval); communicates that threshold to one of the plurality of data capture devices (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); receive notification from the one data capture device that the threshold was logged by the one data capture device, triggering the notification (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); and notify the technician to service the associated business machine, wherein the wireless notifying occurs automatically in response to the notification from the data capture device (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person); and remote interaction with the service contract wherein users modify the threshold (column 5, lines 1-22 – clock can be set for monthly intervals, etc., wherein the usage count is determined), but does not explicitly teach wireless communication or a web interface remote to the operations center. However, it was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently. In addition, it was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of ordinary skill in the art to modify Tarr et al to include a web interface for communication. This would have made the communication process quicker and more efficient.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,351,621 - Richards et al – wireless interaction with memory associated with a replaceable module for office equipment

US 6,532,351 – Richards et al - wireless interaction with memory associated with a replaceable module for office equipment

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL
7/23/07



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